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Hartwig Schwier

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EXAMINER

MILIA, MARK R

ART UNIT

PAPER NUMBER

2625

DATE MAILED: 05/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/936,373

Applicant(s)

SCHWIER ET AL.

Examiner

Mark R. Milia

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 20,21 and 24-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20,21 and 24-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 February 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's amendment was received on 2/10/06 and has been entered and made of record. Currently, claims 20, 21, and 24-42 are pending.

### ***Drawings***

2. Applicant's amendment to Figure 9 to renumber "EPE Print Processor" as "49a" and to insert reference numerals that were previously omitted as overcome the objection as cited in the previous Office Action. Therefore the objection has been withdrawn.

### ***Specification***

3. Applicant's amendment to the specification to correct minor informalities has overcome the objection as cited in the previous Office Action. Therefore the objection has been withdrawn.

***Claim Objections***

4. Applicant's amendment to make claim 21 dependent from claim 20 and to cancel claim 22 has overcome the objection as cited in the previous Office Action. Therefore the objection has been withdrawn.

5. However, claim 24 is objected to because it depends from claim 22, which has been cancelled. The examiner believes the claim was meant to depend from claim 20 and will treat the claim accordingly. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

6. Applicant's amendment to claims 30, 31, and 35-38 to correct antecedent basis problems has overcome the rejection as cited in the previous Office Action. Therefore the rejection has been withdrawn.

***Claim Rejections - 35 USC § 101***

7. Applicant's amendment to claim 41 to render the claim statutory has overcome the rejection as cited in the previous Office Action. Therefore the rejection has been withdrawn.

***Response to Arguments***

8. Applicant's arguments, see pages 11-12, filed 2/10/06, with respect to the rejection(s) of claim(s) 20-42 under 35 U.S.C. 102(b) and 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of newly found prior art. Further, the examiner agrees that Uematsu fails to disclose marking variable data areas in a visually perceptible form such as chromatic marking. However, Uematsu does disclose a master document comprising static and variable data, marking the variable data area, separating the static and variable data, storing the static data at the printer, sending variable data to the printer, and printing the static and variable data as one document.

***Claim Rejections - 35 USC § 103***

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

10. Claims 20, 21, 24-27, 41, and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uematsu in view of U.S. Patent No. 5742879 to Altrieth, III.

Regarding claims 20, 41, and 42, Uematsu discloses a system, method, and computer program product for output of data from a computer system to an output device, comprising: providing a master document having a variable data area and

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having a static data area (see Figs. 1 and 4, column 5 lines 3-16, and column 6 lines 7-23), marking the variable data area (see Fig. 1 and column 6 lines 17-25), inserting variable data into the variable data area to provide a serial data stream with individual documents, said individual documents respectively containing both variable data as well as static data (see Fig. 1 and column 6 lines 7-67), separating said variable data of said serial data stream from said static data on a basis of said marking (see Fig. 1 and column 6 lines 7-67), transmitting said variable data separated from said static data from a first individual document to the output device (see Fig. 1A and column 6 lines 41-63), storing said static data of said first individual document in the output device (see Fig. 3 and column 5 lines 3-19), said static data of following individual documents are not transmitted to said output device (see column 9 lines 6-31), and joining said variable data in turn with the stored static data individual document by individual document in said output device (see Fig. 1 and 10 and column 9 lines 6-31).

Uematsu does not disclose expressly wherein said marking step of said variable data area ensues by a visually perceptible identification, said visually perceptible identification is a chromatic marking.

Altrieth discloses wherein said marking step of said variable data area ensues by a visually perceptible identification, said visually perceptible identification is a chromatic marking (see Figs. 1 and 4, column 3 lines 5-18, column 3 line 66-column 4 line 3, column 5 lines 9-21, column 7 line 15-column 8 line 11, and column 9 lines 34-38, reference shows that digitized documents, which can be displayed on a display device,

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highlight variable data areas that will eventually receive variable data from the control unit).

Uematsu & Altrieth are combinable because they are from the same field of endeavor, merging of variable and static data.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the chromatic marking (highlighting) of the variable data area, as described by Altrieth, with the system of Uematsu.

The suggestion/motivation for doing so would have been to provide greater flexibility and make locating the variable data areas easier for a user.

Therefore, it would have been obvious to combine Altrieth with Uematsu to obtain the invention as specified in claims 20, 41, and 42.

Regarding claim 21, Uematsu further discloses wherein said output device is a printer device (see column 4 lines 1-4 and 21-22).

Regarding claim 24, Uematsu further discloses wherein said output device is a printer device (see column 4 lines 1-4 and 21-22) and said marking ensues with a color that lies outside a printable color spectrum of said printer device (it is well known in the art that if a print job containing color graphics, images, text, etc. is sent to a black and white printer, that the graphics, images, text, etc. will not be printed in color, further it is also known in the art to highlight areas for users to enter information, such as highlighting areas of a form on a webpage in which a user fills in information such as

name, address, etc., and when a user desires to print the form the highlight is not printed)

Regarding claim 25, Uematsu further discloses indicating a scope of said master document (see column 6 lines 7-67).

Regarding claim 26, Uematsu further discloses transmitting characteristic data to said output device with said variable data (see column 5 line 3-column 6 line 67).

Regarding claim 27, Uematsu further discloses wherein said characteristic data includes at least one of: position data, font data, and color data (see column 5 lines 26-53).

11. Claims 29-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uematsu and Altrieth as applied to claim 20 above, and further in view of Heiney et al.

Uematsu discloses (*claim 31*) wherein document data is a page segment (see Fig. 1 and column 6 lines 7-67).

Uematsu and Altrieth do not disclose expressly (*claim 29*) generating said serial data stream in one of the printer languages PCL, Postscript and LCDS, (*claim 30*) wherein one of said master document and the second document is a document of printer language VDS, (*claim 31*) wherein said document of printer language PDS is one of an overlay and a page segment, (*claim 32*) wherein one of said master document and said second document is a document of print data language LCDS, and (*claim 33*) controlling said data output in one of a Windows system environment and a windows-like system environment via data that are input via a user interface.

Heiney discloses (*claim 29*) generating said serial data stream in one of the printer languages PCL, Postscript and LCDS (see column 4 lines 35-42, reference states the use of a PostScript or other similar PDL, of which PCL and LCDS are a part of), (*claim 30*) wherein one of said master document and the second document is a document of printer language IPDS (see column 4 lines 35-42, reference states the use of a PostScript or other similar PDL, of which IPDS is a part of), (*claim 31*) wherein said document of printer language IPDS is one of an overlay and a page segment (see column 4 lines 35-42, column 5 lines 37-49, reference states the use of overlaying in relation to the variable data and master data as can be seen in claims 7 and 14), (*claim 32*) wherein one of said master document and said second document is a document of print data language LCDS (see column 4 lines 35-42, reference states the use of a PostScript or other similar PDL, of which LCDS is a part of), and (*claim 33*) controlling said data output in one of a Windows system environment and a windows-like system environment via data that are input via a user interface (see Figs. 1 and 2, column 3 lines 25-43, and column 4 lines 21-34).

Uematsu, Altrieth, & Heiney are combinable because they are from the same field of endeavor, processing and merging variable data and static data to form an output document.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the use of PDL printer languages in a windows-like system environment as described by Heiney with the system of Uematsu and Altrieth.

The suggestion/motivation for doing so would have been to provide the most accurate print instructions depending on the type of printer that is being utilized for output.

Therefore, it would have been obvious to combine Heiney with Uematsu and Altrieth to obtain the invention as specified in claims 29-33.

12. Regarding claim 34, Uematsu discloses generating a master document (see Figs. 1 and 4, column 5 lines 3-16, and column 6 lines 7-23), linking variable data logically with the master document (see column 5 lines 3-16 and column 6 lines 7-67), and sending the variable data to said output device separated from the data of the master document (see column 6 lines 7-67).

Uematsu and Altrieth do not disclose expressly linking at least one second document logically with said master document; and sending the data of said at least one second document to said output device separated from the data of said master document.

Heiney discloses generating a master document (see Fig. 3 and column 4 lines 21-67), linking at least one second document logically with said master document (see Fig. 3 and column 5 lines 12-20 and 38-49), and sending the data of said at least one second document to said output device separated from the data of said master document (see Fig. 3 and column 3 line 56-column 4 line 10).

Regarding claims 35-40 Uematsu discloses (*claim 35*) storing the variable data in said output device (see column 5 lines 3-19 and column 6 lines 7-67) and (*claim 39*)

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wherein said area of said master document is a page region (see Fig. 1 and column 6 lines 7-67).

Uematsu and Altrieth do not expressly disclose (*claim 35*) storing the data of said at least one second document in said output device, (*claim 36*) joining the data of said master document with data of said second document for output of an individual document, (*claim 37*) wherein said step of logical linking ensues via a referencing, (*claim 38*) specifying an area of said master document wherein said at least one second document is to be linked with said master document, and (*claim 40*) wherein said second document is one of an overlay and a watermark document.

Heiney discloses (*claim 35*) storing the data of said at least one second document in said output device (see column 3 line 56-column 4 line 10), (*claim 36*) joining the data of said master document with data of said at least one second document for output of an individual document (see column 5 lines 52-65), (*claim 37*) wherein said step of logical linking ensues via a referencing (see Fig. 3 and column 5 lines 12-20 and 38-49), (*claim 38*) specifying an area of said master document wherein said at least one second document is to be linked with said master document (see column 5 lines 37-49), (*claim 39*) wherein said area of said master document is a page region (see column 5 lines 37-49), and (*claim 40*) wherein said second document is one of an overlay and a watermark document (see column 5 lines 37-49, reference states the use of overlaying in relation to the variable data and master data as can be seen in claims 7 and 14).

Uematsu, Altrieth, & Heiney are combinable because they are from the same field of endeavor, processing and merging variable data and static data to form an output document.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the linking of a second document to the master document that acts as the variable data as described by Heiney with the system of Uematsu and Altrieth.

The suggestion/motivation for doing so would have been to provide a broader range of data that can be placed in the variable data section and aid in the automation of variable and static data.

Therefore, it would have been obvious to combine Heiney with Uematsu and Altrieth to obtain the invention as specified in claims 34-40.

13. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Uematsu and Altrieth as applied to claim 20 above, and further in view of Porter.

Uematsu and Altrieth do not disclose expressly storing said static data in a macro datafile.

Porter discloses storing said static data in a macro datafile (see Fig. 2 and column 8 line 46-column 9 line 13).

Uematsu, Altrieth, & Porter are combinable because they are from the same field of endeavor, manipulation and merging of variable data to acquire a desired output.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the macro datafile as described by Porter with the system of Uematsu and Altrieth.

The suggestion/motivation for doing so would have been to provide greater flexibility and create more options as a macro can contain a plurality of objects and properties that can be made of use in the merging of data.

Therefore, it would have been obvious to combine Porter with Uematsu and Altrieth to obtain the invention as specified in claim 28.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark R. Milia whose telephone number is (571) 272-7408. The examiner can normally be reached M-F 8:00am-4:00pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler M. Lamb can be reached at (571) 272-7406. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mark R. Milia  
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Art Unit 2625

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